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Supreme Court of the United States

OCTOBER TERM, 1942.

No. 1100 108

JOHN H. WALLACE, JR., doing business as WALLACE LABORATORIES,

Petitioner,

vs.

F. W. WOOLWORTH COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT AND BRIEF IN SUPPORT THEREOF.

W. B. MORTON,
H. STANLEY MANSFIELD,
Counsel for Petitioner.

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28 U. S. Code, Sec. 347 6

TEXT BOOKS CITED

Robinson on Patents, Vol. 1, Sec. 83 9

Patentability of Inventions and the Interpretation of Patents, by Roberts, Vol. 1, Chap. III, pages 185, 245 10

IN THE

Supreme Court of the United States

OCTOBER TERM, 1942.

JOHN H. WALLACE, JR., doing business as WALLACE LABORATORIES,

Petitioner,

vs.

F. W. WOOLWORTH COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, John H. Wallace, Jr., doing business as Wallace Laboratories, prays that a writ of certiorari issue to review the decision of the United States Circuit Court of Appeals for the Second Circuit, entered herein on the 3rd day of March, 1943 (R. 378).

A petition for rehearing by that court was duly presented and was denied on the 19th day of March, 1943 (R. 393).

A certified transcript of the record of the case, including the proceedings in the Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

Summary Statement Of The Matter Involved.

This is an action brought against the respondent in the United States District Court for the Eastern District of New York for infringement of United States Patent No. 2,236,387 by the petitioner Wallace, a joint patentee and the sole owner of the patent.

The District Court held the patent infringed (R. 370, finding 7) but invalid for lack of patentable invention (R. 369) and entered the usual judgment dismissing the complaint (R. 372). On appeal, the Court of Appeals for the Second Circuit affirmed that judgment (R. 394).

The patent in suit covers a composition for checking the flow of perspiration. Preparations for this purpose consisting of solutions of aluminum chloride or aluminum sulphate had been on the market for many years (R. 15, 105). These chemicals are mildly acid. Their acid character is "essential in bringing about the anti-perspirant effect" (R. 72). When heated to temperatures such as occasioned by the ironing of clothing they break down into strong, corrosive mineral acids. They "were unsatisfactory because they frequently produced skin irritations and rotted clothing fabrics in contact with the treated areas" (Opinion of Circuit Court of Appeals, R. 379).

The patentees initiated a program of chemical research to find an innocuous substance which could be added to the old preparations and would be inert with respect to the mildly acid aluminum sulfate or aluminum chloride constituting the anti-perspirant agent, but would react with and render harmless the strong sulfuric or hydrochloric acid which might be produced. After a series of cut and try experiments in which they "tried 'a complete range of alkalies' to neutralize the acid", they finally tried "urea and related compounds. The urea seemed to do the trick" and the result was a harmless and effective anti-perspirant, "a commercially satisfactory article that met with wide success" (Opinion of Circuit Court of Appeals, R. 381).

Urea is a known organic chemical substance. Chemists generally knew that urea would combine with strong mineral acids (Shipp patent, R. 177), and it had been proposed that urea be used to stabilize salts such as aluminum acetate and aluminum formate which normally decompose and produce insoluble compounds upon standing (Koch patent, R. 215).

The Circuit Court of Appeals was confused as to the facts in including Killian with Montenier in its statement that:

> "urea was the neutral protective ingredient that about the same time occurred to Wallace, Hand, Killian and Montenier."

The application for the patent in suit was in interference in the Patent Office with the application of one Montenier. Priority was awarded the joint patentees Wallace and Hand (R. 317). Killian, on behalf of petitioner, when petitioner's product was first marketed, conducted a series of tests to establish the efficacy of the protective agent in checking the corrosive action of the strong acids on fabrics (R. 12, 13).

The Court's ruling is in effect a holding that the validity of a patent is impaired by an interference in the Patent Office, even though the patentee receive the award of priority.

The Circuit Court of Appeals for the Second Circuit held that what the patentees did was the result of skillful experimentation where the principles of investigation were well known, and that this required "mere routine work rather than imagination" and did not involve invention (Opinion, R. 381). While conceding that "such steps might perhaps . . . lead to invention if the result was sufficiently unexpectable", that Court found that "No particular talent was involved in developing the plaintiff's product but only a process of routine experimentation by industrious chemists" (Opinion, R. 381).

The Question Presented.

Does the patentability of a new combination, derived by experimentation and productive of a new and desirable result, depend at all upon the mental process by which it was discovered?

The Reason For Granting The Writ.

Determination of the question of invention herein by the Circuit Court of Appeals for the Second Circuit by consideration of the mental process by which the thing patented was discovered is in direct conflict, on a point of law, with the doctrine that it is the fact of accomplishment rather than the method of accomplishment with which judicial inquiry is concerned, which doctrine has been announced by the Circuit Court of Appeals for the Seventh Circuit in *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. (2d) 812, and has been applied by this Honorable Court in a long line of decisions. The petition for the writ should be granted "because of the importance of the problem and to the public" and because of "the contrarity of views" which have developed concerning it (*Freeman* v. *Bee Machine Co., Inc.*, —— U. S. ——; 57 USPQ 349, 351, decided June 1, 1943).

WHEREFORE, your petitioner prays that a writ of certiorari issue out of and under the seal of this Court directed to the United States Circuit Court of Appeals for the Second Circuit, commanding said court to certify and send to this Court, on a date to be designated, a full transcript of the record and all proceedings of said Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court and that the judgment of the Circuit Court of Appeals be

reversed, and that petitioner may be granted such other and further relief in the premises as to this Court may seem just and proper.

JOHN H. WALLACE, JR., doing business
as WALLACE LABORATORIES,

By W. B. MORTON,
Counsel for Petitioner.

Dated: New York, N. Y.,
June 16, 1943.

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

Opinions Of The Courts Below.

The opinion of the District Court for the Eastern District of New York herein appears in 45 F. Supp. 465, and the opinion of the Circuit Court of Appeals for the Second Circuit in 133 F. (2d) 763.

Jurisdiction.

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925, c. 229 (28 U. S. Code, Sec. 347). The decision of the Circuit Court of Appeals for the Second Circuit, which petitioner seeks to have reviewed, was entered March 3, 1943 (R. 378), and a petition for rehearing duly filed in that Court was denied by that Court on March 19, 1943 (R. 393).

Statement Of The Case.

The essential facts of the case are stated in the accompanying petition for a writ of certiorari.

Specification Of Errors.

The errors which petitioner will urge if the writ of certiorari is issued are that the Circuit Court of Appeals for the Second Circuit erred:

1. In holding the patent in suit invalid for lack of invention as to the claims in issue.

2. In holding the patent in suit invalid because the thing patented resulted from skillful experiments involving no imagination and insufficient talent and achieving a result not sufficiently unexpectable.

3. In holding that urea as a protective ingredient was a result achieved by other chemists contemporaneously through investigation indicated by familiar chemical principles.

4. In not holding the patent in suit valid and infringed as to the claims thereof in issue.

Argument.

The Circuit Court of Appeals for the Second Circuit decided herein that the thing patented lacks invention because its discovery did not involve "imagination", because the result was not "sufficiently unexpectable", and because "No particular talent" was involved in the process of development (Opinion, R. 381). The judicial inquiry was thus subjective, seeking to weigh the mental processes exercised by the patentees before they made their discovery.

In direct conflict with the doctrine so announced, the Circuit Court of Appeals for the Seventh Circuit in *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. (2d) 812, stated that the objective test should apply in determining the question of invention,—that it is the character or personality of the thing invented as contrasted with what went before it rather than the mental process or method of discovery with which judicial inquiry is concerned. That Court said (pp. 816, 817, 818):

> "We are advised and believe that in the field of science nearly all advance is made in laboratories where many experiments are made and discoveries result from the trial and error method.
>
> * * * * *
>
> The test of '*flash* of genius' has been applied to curtain the field of patentable discovery and to eliminate from the protection of patents, all products (even though they came from the superior mind of genius)

which were, nevertheless, the product of prolonged study and step by step advance. In short, it would eliminate nearly all the advances of history, in science, and in the field of mechanics. All that would be left are the products and processes which come to a genius, only occasionally, as flashes. Only a matured child prodigy (if there is any such being) is capable of experiencing such flashes.

* * * * *

The test of a 'flash of genius' should be rejected not only because it is incapable of acceptable definition but because it injects into the statute something not appearing therein. The Federal decisions covering a century contain many to the effect that *it is the fact of accomplishment*,—novelty appearing, rather than the method of accomplishment with which judicial inquiry is concerned.*

The questions for the court are: What is the new product? What advance does it show over those in use or known to the art? Our interest is in the child, not in how or where it was born or who were its parents. Section 31, Title 35, U. S. C. A.

Nowhere in the statute can be found any words which require, or permit us to inquire into the quality of mind or the activity of the mind of the inventor to determine the patentability of his products or processes. Congress was interested in protecting the product of the mind,—not in whether it came as a flash to the mind or as a happy thought, or by long painstaking search and experimentation."

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*Citing *Diamond Rubber Co.* v. *Consolidated Tire Co.*, 1911, 220 U. S. 428, 31 S. Ct. 444, 55 L. Ed. 527; *The Barbed Wire Patent* (*Washburn & Moen Mfg. Co.* v. *Beat 'Em All Barbed-Wire Co.*), 1892, 143 U. S. 275, 12 S. Ct. 443, 36 L. Ed. 154; *Webster Loom* v. *Higgins*, 1881, 105 U. S. 580, 26 L. Ed. 1177; *Krementz* v. *Cottle Co.*, 1893, 148 U. S. 556, 13 S. Ct. 719, 37 L. Ed. 558; *Eibel Process Co.* v. *Minnesota, etc.*, 1923, 261 U. S. 45, 43 S. Ct. 322, 67 L. Ed. 523; *Minerals Separation Co.* v. *Hyde*, 1916, 242 U. S. 261, 37 S. Ct. 82, 61 L. Ed. 286.

An authoritative settlement of this conflict is of great importance to the public. Under the Second Circuit rule, patent protection is denied to scientists when, due to their faith, perseverance and confidence, they expect the result that they ultimately achieve through trial and error. Confidence in eventual achievement of a desired objective and persistent striving to attain it despite the discouragement of repeated failures has characterized the development of the most important scientific advances. Edison, confident of the result he sought, tried many unsatisfactory expedients before he produced a successful incandescent lamp*. The denial of patent protection to the scientist who strives by trial and error to attain his objective, and the tentative promise of protection to those who may by accident stumble on something of value that they did not seek or expect, will necessarily discourage and curtail intelligent research. Until the conflict here presented is resolved, the public will be deprived of such intelligently achieved developments as are promoted by patent protection.

Three intelligent analyses of the question of patentable invention indicate the importance of resolving the legal conflict herein presented.

In 1890, Robinson, in his work on patents, stated that the nature of the mental process productive of the new thing is of no consequence in determining invention.

> "The patient labors of a lifetime, the unpremeditated flash of an original thought upon the mind, the revelation made to an appreciative intellect by some trivial accident, all stand upon an equal footing both in character and merit, and are entitled to the same reward" (Robinson on Patents, Vol. 1, Sec. 83, p. 127).

About thirty-five years later Roberts, being convinced that reliable definitions of patentable invention must be

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*Edison Electric Light Co. v. United States Electric Lighting Co., 52 Fed. 300, 303-306 (C. C. A. 2, 1892).

found in the decisions of this Honorable Court, made a careful and exhaustive analysis of those decisions and found that with only three exceptions the criterion of invention applied was "wholly dependent upon objective evidence free from the influence of subjective bias", and that the test was applied to the physical thing devised "without regard to extraneous circumstances attending its origin or exploitation" (Patentability of Inventions and the Interpretation of Patents, by Roberts, Vol. 1, Chap. III, p. 245, see also pp. 170, 171 and 186).

About a year after his appointment to the Circuit Court of Appeals for the Second Circuit, Judge Jerome N. Frank was confronted with the question of invention in *Picard* v. *United Aircraft Corporation*, 128 F. (2d) 632. He quite properly felt "reluctantly constrained to join" the majority of that Court and accepted the test of invention that it applied* in view of the greater experience of his colleagues (128 F. (2d) at 639). In his concurring opinion, Judge Frank analyzed "the startling implications of Judge Hand's negative test of invention" (128 F. (2d) at 639). He noted that disinterested scientific advisers to the court would have to determine whether the thing patented is more than what results "through trial and error" and the "exercise of persistent and intelligent search for improvement", and that if the test were "informedly applied", "only an infinitesimal percentage of so-called inventions will be patentable" (128 F. (2d) at 640). He concluded as follows with regard to the application of the test under the existing system of judicial determination (p. 641):

> "If all that be true, then, perhaps, with exceedingly few exceptions, it will only be to the untrained eye of

*In the majority opinion, the Court, speaking through Judge Learned Hand, said:

> "Unless we are to mistake for invention the slow but inevitable progress of an industry through trial and error, and confer a monopoly merely upon the exercise of persistent and intelligent search for improvement, there was no invention in this" (128 F. (2d) at 636).

a member of the judiciary (i. e., to a scientific amateur) that anything will appear to be an invention. If Judge Hand's yardstick is applied, a valid patent will, usually, be a function of judicial scientific ignorance."

Conclusion.

It is urged, therefore, that the petition for writ of certiorari be granted.

Respectfully submitted,

W. B. MORTON,
H. STANLEY MANSFIELD,
Counsel for Petitioner.

Dated: New York, N. Y.,
June 16, 1943.

BRIEF FOR THE RESPONDENTS IN OPPOSITION

(4)

JUL 12 1943
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

October Term, 1943.

No. 108.

JOHN H. WALLACE, JR., doing business as WALLACE LABORATORIES,

Petitioner,

AGAINST

F. W. WOOLWORTH COMPANY,

Respondent.

BRIEF ON BEHALF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

ROBERTS B. LARSON,
Counsel for Respondent.

LODER APPEAL PRESS, INC., 65-67 Duane St., N. Y. C., Tel. WOrth-2-0689

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Supreme Court of the United States

OCTOBER TERM, 1943.

JOHN H. WALLACE, JR., doing business as WALLACE LABORATORIES,
Petitioner,

AGAINST

F. W. WOOLWORTH COMPANY,
Respondent.

No. 108.

Brief on Behalf of Respondent in Opposition to Petition for Writ of Certiorari.

The petition for writ of certiorari raises no question of constitutionality, jurisdiction, conflict of decisions, local law or question of Federal law not heretofore settled by decisions of this Court or question of departure from accepted and usual course of judicial proceedings.

Apparently the petitioner desires to have this Court review its decision in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, in which the Court stated that the new device must reveal a "flash of creative genius", not merely the skill of the calling. The petitioner in his brief argues that the Second Circuit decision in this case and the Seventh Circuit decision in *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. (2) 812, are in conflict. Actually, both courts held the patents which were before them to be invalid on the ground that the alleged inventions were "not beyond the ken or practice of the ordinary mechanic" (132 F. [2] 818) and "no particular talent was involved in developing the plaintiff's product" (R., p. 381).

The Seventh Circuit Court of Appeals analyzed and commented on this Court's "flash of creative genius" rule, whereas the Second Circuit Court of Appeals did not make reference to that rule. There, however, was no conflict on a point of law or the applicability of this Court's decision. Both Courts held in their respective cases that in view of the art there was no invention in the respective patents before them.

The Facts.

The patentees, Wallace and Hand, claim to have invented a perspiration inhibitor composition consisting of aluminum chloride and aluminum sulphate to which had been added urea for the purpose of neutralizing excess acidity.

The District Court for the Eastern District of New York (Judge Byers) held that the patent in suit "does not embody patentable invention over the prior art" (R., p. 371) and in its conclusion the Circuit Court of Appeals agreed (R., p. 381). Judge Byers was of the opinion that the Koch patent exemplified the prior art over which there was no invention (R., p. 371), whereas the Circuit Court of Appeals relied, not only upon the Koch patent, but upon other patents and prior knowledge. In this connection, the Circuit Court of Appeals held:

> "The plaintiff, Wallace, testified that in 1935 he knew that if urea was added to an acid it would reduce the acidity. The plaintiff's witness Killian testified that he possessed the same knowledge when he began his experiments early in 1936. U. S. Patent No. 2,011,292 to Koch (issued August 13, 1935) taught that a solution of aluminum formate containing 8 per cent. of urea could be used with special advantage in the textile industry because the compound did not contain any substances having 'a detrimental effect.' The U. S. Patent No.

2,174,534 to Shipp (issued October 3, 1939, the application for which was filed April 22, 1936) also suggested the use of urea to retard the deleterious effect of sulphuric acid upon cellulose fabrics. The U. S. Patent No. 2,145,583 to Carlson (issued January 31, 1939, the application for which was filed December 6, 1934) was for a shaving cream tending to stop perspiration under the arms. It mentioned aluminum sulphate as an anti-perspirant and included zinc stearate as a protective ingredient and stated that the mixture would be 'harmless to clothing.' Montenier in U. S. Patent No. 2,230,082 disclosed that the excess acidity of aluminum chloride was destructive to clothing fabrics in anti-perspirant compounds and prescribed the use of urethene, urea and other agents to counteract the effect of the excess hydrochloric acid.

In the Spring of 1935, the patentees in this case began to work on an anti-perspirant that would not injure clothing. First they used creosol sulphuric acid and found it too strong and accordingly added percentages of sodium hydroxide, citric acid, phosphoric acid and tartaric acid, but the result was unsatisfactory. They then tried 'a complete range of alkalis' to neutralize the acid and finally urea and related compounds. The urea seemed to do the trick and, when aluminum sulphate was used as an equivalent of the creosol sulphuric acid, produced a commercially satisfactory article that met with wide success."

On the basis of this prior art evidence, the Court of Appeals held the patent invalid.

Argument.

The lower tribunals were both of the opinion that the patent in suit did not disclose invention in view of the

prior art and prior knowledge and, they having so disposed of the case against the petitioner, this Court will not review such concurrent decisions. *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U. S. 175, 178-179. Nor will this court review by certiorari evidence or specific facts. *Southern Power Co.* v. *North Carolina Public Service Co.*, 263 U. S. 508, 509.

Petitioner attempts, by argument, to create an alleged conflict of decision between the Second and Seventh Circuits, but it seems clear that there is no diversity of opinion. Both Courts held the patents which were before them to be invalid for want of invention over the prior art and prior knowledge, but both Courts nevertheless followed the well known rule that if the patent covered what was obvious the patent could not be sustained.

It is true that Judge Evans in his opinion in the Seventh Circuit case, was not disposed to apply the "flash of creative genius" test, but came to the conclusion that the patent before him lacked invention because the development of the subject matter thereof was within the capacity of the mechanic in the art. In the Second Circuit case the Courts came to the same conclusion without reference to the "flash of creative genius" rule. Therefore, there is no conflict of decision but rather harmony in the reasoning of the two Courts in arriving at the same conclusion of lack of invention in either patent.

CONCLUSION.

It is respectfully submitted that there is no merit in the petition for writ of certiorari and that the petition accordingly should be denied.

Respectfully submitted,

ROBERTS B. LARSON,
Counsel for Respondent.

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No. 108

JOHN H. WALLACE, JR., doing business as WALLACE LABORATORIES,
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F. W. WOOLWORTH COMPANY,
Respondent.

REPLY BRIEF ON BEHALF OF PETITIONER

W. B. MORTON,
H. STANLEY MANSFIELD,
Counsel for Petitioner.

Supreme Court of the United States

OCTOBER TERM, 1943

No. 108

JOHN H. WALLACE, JR., doing business as WALLACE LABORATORIES,

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F. W. WOOLWORTH COMPANY,

Respondent.

REPLY BRIEF ON BEHALF OF PETITIONER

This reply brief is believed necessary because of an apparent attempt by respondent to mislead the Court.

Respondent incorrectly asserts that petitioner seeks a review of the doctrine, announced by this Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, that the new device must reveal a "flash of creative genius" not "merely the skill of the calling" (Resp. Br. p. 1). Respondent notes that the Seventh Circuit Court of Appeals commented on this rule in the *Chicago Steel Foundry* case*, but the Second Circuit Court of Appeals herein did not. By thus referring to a point in which the decisions of those Courts are not in conflict, respondent seeks to obscure the fact that they are in conflict on the fundamental question of whether invention is to be determined by considering the thing patented or the method of its conception.

**Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. (2d) 812.

Petitioner does not seek a review of this Court's decision in the *Cuno Engineering Corp.* case, *supra.* There, as in earlier decisions, this Court considered "the new device" to determine whether it revealed "the flash of creative genius" or "merely the skill of the calling" (314 U. S. 84, at 91).

The conflict pointed out in the petition herein does not concern the "flash of creative genius" rule to which the Second Circuit Court of Appeals made no reference. It concerns the nature of judicial inquiry in determining patentability, as to which that Court made its position clear. The Second Circuit Court of Appeals decided herein that the thing patented lacked invention because its discovery involved "mere routine work rather than imagination" and because "no particular talent was involved in developing plaintiff's product" (R. 381), thus clearly indicating its inquiry concerned the manner or method of discovery and not the thing discovered. The Seventh Circuit Court of Appeals expressly stated that "*it is the fact of accomplishment,*—novelty appearing, rather than the method of accomplishment with which judicial inquiry is concerned." (132 F. (2d) at 817).

The importance of an authoritative pronouncement by this Court on the conflict respondent seeks to obscure is emphasized by the report of the National Patent Planning Commission, published in a special edition of the Patent, Trade Mark and Copyright Weekly Reports, Vol. 57, No. 12, under date of June 19, 1943. That report characterizes the lack of a uniform test for determining patentable invention as "the most serious weakness in the present patent system" and makes the following recommendation—

> "The Commission therefore recommends the enactment of a declaration of policy that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished."

Pending enactment of the recommended legislation, a positive ruling by this Court on this question is of great importance to the general public.

Respectfully submitted,

W. B. MORTON
H. STANLEY MANSFIELD
Counsel for Petitioner